

REMARKS

Claims 1-21 are pending in this application. Claims 1, 4, 8, 10, 14, and 18 are independent claims. Claims 10-21 are new claims. No claims are amended, and no claims are canceled in the foregoing amendment. Reconsideration and allowance of the present application are respectfully requested.

Claim Rejections under 35 U.S.C. §102(e) – Bonta

Claims 1-6 and 8-9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,337,983 to Bonta et al. (hereinafter "Bonta"). Applicants respectfully traverse this rejection, as detailed below.

MPEP §2131 sets forth the standard for a 35 U.S.C. § 102 rejection:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *MPEP §2131 (quoting Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Id. (quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

In addition, "the reference must be enabling and describe the applicant's invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

The 35 U.S.C. § 102(e) anticipation rejection of claims 1-6 and 8-9 is improper because the rejection does not meet all of the above criteria for the reasons and explanations set forth below.

With regard to claim 1, the Examiner points to step 622 (transmit normal PSMM) of FIG. 4 as being equivalent to transmitting a pilot strength measurement message from a mobile terminal at a first transmit power level determined by the mobile terminal. The Examiner then points to step 632 (transmit rescue PSMM) of FIG. 4 as being equivalent to transmitting the pilot

strength measurement message from the mobile terminal at a second transmit power level determined by the mobile terminal, wherein the second transmit power level is greater than the first transmit power level. Applicants disagree as there are no teachings in Bonta to suggest that the rescue PSMM is transmitted at a greater power level than the normal PSMM.

Bonta is directed to a method and apparatus for handoff to a rescue channel. During normal operation, a mobile transmits the normal PSMM to its serving base station. However, when a mobile initiates a rescue operation, if there are eligible neighbor cell pilots, the mobile promotes one of the neighboring base stations to the active set (step 630). Subsequently, the mobile transmits the rescue PSMM message (step 632) to indicate the pilot strength measurements of the neighboring (rescue) cells used in the rescue operation. With regard to step 632, Bonta states:

In yet a further alternate embodiment, the mobile unit uses mechanisms other than a PSMM for informing the infrastructure of which rescue cells it is using for rescue, such as sent in step (632) and received in step (830). For example, an indication of the rescue cells being used by mobile unit 330 may be signaled repeatedly in the first few frames exchanged between mobile unit 330 and the rescue cell (BTS 312) as a new message. Alternatively, the information could be transmitted on a separate channel such as an access burst on an access channel similar to the procedure used on a new call origination. (see col. 13, lines 55-65).

Accordingly, the rescue PSMM is simply a message used to inform the infrastructure of which rescue cells the mobile is using for rescue. This neither teaches nor suggests that the rescue PSMM is transmitted at a power level greater than the normal PSMM as alleged by the Examiner.

With regard to col. 13, lines 44-46 pointed to by the Examiner, in its greater context Bonta states:

In an alternate embodiment, the mobile unit 330 sends a PSMM to the infrastructure using up to its maximum transmit power. This occurs just prior to step 602, after 6 consecutive reverse link frame errors are detected, or it may occur some time after step 602. If the PSMM is sent after 602, then the mobile unit will need to briefly turn on its transmitter long enough to send the PSMM. If the infrastructure (BSC 351) is able to receive the PSMM prior to 804, then the infrastructure can use this information to assist in selecting the rescue cell or cells. (see col. 13, lines 44-54).

Here, Bonta indicates that the PSMM messages sent by the mobile unit may be sent at an arbitrary transmit power level up to the mobile unit's maximum transmit power. This simply means that the mobile may transmit PSMM messages at a desired transmit power level, but does not teach or suggest transmitting the rescue PSMM from the mobile terminal at a second transmit power level determined by the mobile terminal, wherein the second transmit power level is greater than the first transmit power level, as alleged by the Examiner.

Furthermore, elsewhere Bonta states that “[t]he rescue procedure is enhanced by initially attempting the transmission at maximum power an unacknowledged message from the mobile containing the current pilot channel signal strengths measured from the strongest n cells (subsequently this message will be referred to as an emergency PSMM).” (see col. 3, lines 11-16). This passage suggests the opposite of that alleged by the Examiner, that the first (initial) PSMM transmission is at maximum power. Thus, each successive PSMM transmission would necessarily be at either the same (maximum) power or at a different (reduced) power, in complete contrast to the claimed invention.

For at least the above reasons, Applicants submit that Bonta does not teach or suggest “transmitting a pilot strength measurement message from a mobile terminal at a first transmit power level determined by the mobile terminal” and “transmitting the pilot strength measurement message from the mobile terminal at a second transmit power level determined by the mobile terminal, wherein the second transmit power level is greater than the first transmit power level” as recited in claim 1. Similarly, Bonta does not teach or suggest “transmitting a pilot strength measurement message from the mobile terminal at a first transmit power level determined by the mobile terminal, which first transmit power level is less than a maximum transmit power level” and “incrementing a transmit power level from the mobile terminal prior to receiving a hand-off direction message and completion of the call recovery” as recited in claim 4. Also similarly, Bonta does not teach or suggest “instructions to transmit a pilot strength measurement message from the mobile terminal at a first transmit power level determined by the mobile terminal” and “further instructions to transmit the pilot strength measurement message from the mobile terminal at a second transmit power level determined by the mobile terminal, wherein the second transmit power level is greater than the first transmit power level” as recited in claim 8.

Thus, Applicants submit that Bonta fails to teach or suggest all the features of independent claims 1, 4 and 8. Independent claims 1, 4 and 8 are thus allowable over Bonta. In addition, dependent claims 2, 3, 5, 6, and 9 are similarly allowable over Bonta at least for their dependence from an allowable base claim.

Therefore, Applicants respectfully request that this rejection of claims 1-6 and 8-9 under 35 U.S.C. §102 be withdrawn.

Claim Rejections under 35 U.S.C. § 103(a) – Bonta in view of Dalal

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bonta in view of U.S. Patent No. 6,633,554 to Dalal et al. (hereinafter “Dalal”). Applicants respectfully traverse this rejection, as detailed below.

The patentability of independent claim 4 set forth above precludes a rejection of claim 7 depending therefrom, because a dependent claim may not be rejected as obvious if the independent claim from which it depends is nonobvious. *See In re Fine*, 5, USPQ.2d 1596, 1600 (Fed Cir. 1988), *see also* MPEP § 2143.03.

Therefore, Applicants respectfully request that this rejection of dependent claim 7 under 35 U.S.C. § 103(a) be withdrawn.

New Claims

Newly added independent claims 10, 14, and 18 each recite the feature of, “the second transmit power level being greater than the first transmit power level.” As discussed above, the cited art fails to disclose, teach, or suggest at least this feature of independent claims 10, 14, and 18. Thus, Applicants believe that independent claims 10, 14, and 18, as well as newly added dependent claims 11-13, 15-17, and 19-21 depending variously therefrom, are also allowable.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicant submits that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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